

Applicant : Orlando W. Stephenson III  
Appln. No. : 10/810,911  
Page : 10

### REMARKS

This is in response to an Office Action mailed August 30, 2007. Claims 1-25 are pending in the present application. A petition for extension of time to respond is attached. Reconsideration is respectfully requested for the following reasons.

The undersigned gratefully acknowledges the courtesies extended during a telephone interview with Examiner Duffy and his Supervisor Examiner Pezzuto, conducted October 25, 2007, in which the independent claims, recent Office Action, and cited art was discussed along with proposed amendments. Acceptable claim language was not agreed upon, but Examiner Duffy (and Supervisor Pezzuto) agreed to further consider the points discussed. Further, they agreed that an expert declaration supporting the items discussed may be beneficial and that they would consider same. For the record, a good amount of the discussion focused on the fact that the prior art Cole 6,475,087 discloses a gaming cabinet without any cross member, and that Englman 2003/0157978 discloses a gaming cabinet with a fixed cross member (which is the problem addressed by the present invention). Thus, Applicant disagreed that Cole and Englman could suggest a gaming cabinet with an adjustable cross member, as discussed below. The discussion below is believed to be consistent with the interview, but it is noted that the claim language has been further modified from that discussed in the interview.

The original title was objected to. A new title has been provided, and the Examiner indicated during the interview that it was generally acceptable.

Claims 8-18 were rejected under 35 U.S.C. § 112 since the Examiner took the position that "bezel" was unclear. This rejection has been addressed, and all claims are now believed to be clear and definite by substituting the word "mount" for the word "bezel." This amendment

Applicant : Orlando W. Stephenson III  
Appln. No. : 10/810,911  
Page : 11

is believed to be acceptable based on the interview, where the Examiner commented that he felt it was acceptable. However, for the record, it must be noted that this change was done to expedite prosecution by avoiding unnecessary argument and expense by Applicant. It is submitted that the term “bezel” is used and understood by skilled artisans in this industry, and also is well described and defined in the present specification through illustration and discussion, and still further that many dictionaries supporting the term as used in this case. (For example, a “bezel” is defined as “a rim that holds a transparent covering,” in Webster’s Ninth New Collegiate Dictionary, copyright 1991). Thus, this amendment to the claims is not believed to adversely affect a broad reading of the scope of these claims, especially under the Doctrine of Equivalents analysis.

The present invention focuses on a cross member that can be adjustably secured to a gaming cabinet door for dividing its front opening into upper and lower portions. This is very beneficial because it allows gaming cabinet doors, which are expensive and complicated structural members, to have their openings selectively divided late in the assembly/manufacturing process (or in a refurbish or retrofit or “updating” process) into upper and lower window portions optimally designed for particular games. This is important since games change so often in today’s gaming industry. Historically, the cross members were integrally permanently secured to the door, such that no such adjustment of their cross member was possible after the door’s “shell” was created. This results in a cost penalty and reduction in manufacturing flexibility, since doors with “set” openings must be thrown away and/or totally replaced in order to change a size of the openings, which is expensive. Concurrently, it is expensive and impractical to cut off the permanently secured cross members and re-attach

Applicant : Orlando W. Stephenson III  
Appln. No. : 10/810,911  
Page : 12

them, making this alternative unrealistic.

Contrastingly, the cited patent, Cole 6475087 discloses a gaming cabinet with a front opening. Notably, Cole does not disclose any cross member. Cole does disclose a replaceable panel (68) attached to his door (see Fig. 3) which can be replaced for different games. Notably, the panel (68) may provide a “screening function” since it can have one or more opaque portions (70) and transparent portions (72) thereon. (Column 6, line 53.) However, “opaque portions” are not equivalent to cross members since they are painted flat surfaces. Further, opaque portions are fixed medium, and they are not adjustable in any sense. Notably, the bracketry for holding the panels (68) are fixed to the door and are not adjustable either.

Contrastingly, the cited publication, Englman publication 2003/0157978 A1 discloses a gaming machine with a door defining an opening and a cross member dividing the opening into upper and lower portions. However, the cross member in Englman is permanently attached to the door in a fixed position such that it cannot be adjusted. The details of attachment of the cross member are not found in Englman, but nothing in Englman suggests that the cross member is adjustable, nor removable, nor attached with fasteners. In fact, Englman has the very problem solved by the present invention. Specifically, since Englman’s cross member is permanently set and cannot be adjusted, Englman’s door is limited to games that match predetermined upper and lower opening sizes in the door.

It is noted that the claims 1 and 10 were amended to more clearly recite cross member’s adjustable engagement with the door, including it is secured in a selected vertically-adjusted position (claim 1) or in a selected vertical position (claim 10). This

Applicant : Orlando W. Stephenson III  
Appln. No. : 10/810,911  
Page : 13

is entirely consistent with the specification, such as on page 3, paragraph [0013], line 12, "The cross member 12 is adjustably secured to the door 6, such that the vertical position of the cross member 12 can be adjusted in the direction of the arrow "A" (Fig. 1) to vary the size of an upper opening 14 formed above the cross member 12, and to adjust the size of a lower opening 15 below the cross member 12." Notably, the fact that the cross member includes fasteners removably securing the cross member (claim 1) is inherent in the threaded studs 42 and nuts 40.

The claims 1-18 were rejected as obvious and unpatentable over Cole in view of Englman. This is traversed for the following reasons.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Claim 1 recites a gaming machine including, among other things, a cabinet defining an internal space, a door for closing off the cabinet, at least one sheet mounted to the door that is in part see-through, and a horizontal cross member extending across the enlarged opening. The cross member has "opposite ends positioned adjacent the vertical side edges when in any one

Applicant : Orlando W. Stephenson III  
Appln. No. : 10/810,911  
Page : 14

of a plurality of vertically-adjusted positions” and includes “fasteners removably securing the cross member to the door in a selected one of the vertically-adjusted positions, such that the vertical position of the cross member can be adjusted during installation to vary the size of an upper portion of the enlarged opening above the cross member, and a lower portion of the enlarged opening below the cross member”.

As noted above, Cole does not disclose any cross member. Englman discloses a cross member, but the cross member is fixed. Englman does not disclose or suggest a cross member that is adjustable, nor removable, nor attached with fasteners. In fact, Englman has the very problem solved by the present invention. Specifically, since Englman’s cross member is permanently set and cannot be adjusted, Englman’s door is limited to games that match predetermined upper and lower opening sizes in the door.

Thus, the first criteria for an obviousness rejection (i.e., that there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings) is not met. The attached expert declaration supports the position that this first criteria is not met. The rejection in the Office Action does not address this deficiency of the references.

The second criteria for an obviousness rejection is that there must be a reasonable expectation of success. Since the cited art does not disclose or suggest an adjustably-positioned cross member, it is difficult to gauge what is “a reasonable expectation of success.” It is fundamental that part of an invention can be discovery or recognition of a problem. Further, the teaching or suggestion to make the claimed

Applicant : Orlando W. Stephenson III  
Appln. No. : 10/810,911  
Page : 15

combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. MPEP 2143; *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The attached Expert Opinion supports the lack of any "expectation of success" under this second criteria on the basis that gaming cabinet doors have been made like "vaults" for years. Hence, there is no expectation of success in trying to come up with a vertically adjustable cross member, which is a substantial step away from a "vault-like" solid structure, especially where the gaming industry expects fixed, solid, permanent, vault-like structures.

Finally, a third criteria for an obviousness rejection is that the prior art reference (or references when combined) must teach or suggest all the claim limitations. As noted above, they don't. Specifically, the present invention provides a new function (i.e., vertically adjustable cross member) which is not shown or suggest in the art. Also, see the attached Expert Declaration which supports this position.

The US Supreme Court in *KSR Int'l v Teleflex, Inc*, 82 U.S.P.Q.2d 1385 (U.S. 2007) took the position that the test for obviousness was broader than a simple test of "teaching, suggestion, or motivation." However, the KSR decision does not change the fact that the elements and/or function must be shown or suggested in the art. In fact, the KSR decision specifically encourages a common sense approach. In the present case, neither cited art of Cole and/or Englman show or suggest a vertically-adjustable cross member, nor even a reason to modify the existing art to make one. Applicant argues that it is not "common sense" to combine a first reference that does not include any cross member (i.e., Cole) with second reference showing a permanently secured cross

Applicant : Orlando W. Stephenson III  
Appln. No. : 10/810,911  
Page : 16

member (i.e., Englman) to reject claim 1 which requires a cross member that is removably secured by fasteners in a selected vertically-adjusted position, as defined in claim 1. The benefits of such a unique construction are not foreseeable, except through hindsight that uses the teaching of the present specification . . . which is improper.

In regard to secondary considerations supporting the unobviousness of the present invention, we note that the present invention as defined in claim 1 resolves a long-felt but unresolved need in the industry for reconfigurable gaming cabinets that are able to be reconfigured to support changing games in this industry . . . without having to throw away existing gaming cabinets (or at least throw away and replace expensive complex doors). As noted in the Expert's Declaration, the present invention has contributed to the present Applicant's success in the marketplace, and is believed to be counterintuitive (i.e., the prior art teaches away from the present invention) due to an overriding antitheft-mentality (i.e., the gaming cabinets should be "vault-like") in gaming industry.

The claims 2-9 and 22-24 depend from base claim 1 and are allowable since claim 1 is allowable for the reasons given above. These claims 2-9 and 22-24 are also allowable since they define unobvious combinations with the subject matter of claim 1. For example, the cited art (including Cole and Englman) do not disclose or suggest a mount as defined (claims 8 and 22), nor a door and cross member with mating beveled surfaces, where the cross member fits closely against but is not attached to the beveled outer surface of the door (claim 9), a flat mount (claim 23), nor first and second fasteners as defined (claim 24).

Claim 10 is also patentable over Cole and Englman for reasons similar to those given above in regard to claim 1. Claim 10 recites a gaming machine including, among other things,

Applicant : Orlando W. Stephenson III  
Appln. No. : 10/810,911  
Page : 17

a cabinet having a front side, a door pivotably mounted to the cabinet with an enlarged opening, and a mount secured to the door and having an enlarged opening therethrough. A cross member is fastened to the mount and extends across the enlarged opening in the door. The cross member adjustably engages the door to selectively divide the opening but is secured by the mount in a selected vertical position.

As noted above, Cole does not disclose any cross member. Englman discloses a cross member, but the cross member is fixed. Englman does not disclose or suggest a cross member that is adjustable, nor removable, nor attached with fasteners. In fact, Englman has the very problem solved by the present invention. Specifically, since Englman's cross member is permanently set and cannot be adjusted, Englman's door is limited to games that match predetermined upper and lower opening sizes in the door. Also, neither Cole nor Englman disclose a mount secured to a door and a cross member fastened to the mount, with the cross member fastened and secured to the mount in a selected vertical position.

Thus, the first criteria for an obviousness rejection (i.e., that there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings) is not met. The attached expert declaration supports the position that this first criteria is not met. The rejection in the Office Action does not address this deficiency of the references.

The second criteria for an obviousness rejection is that there must be a reasonable expectation of success. Since the cited art does not disclose or suggest an adjustably-positioned cross member, nor a mount for securement when in a selected



Applicant : Orlando W. Stephenson III  
Appln. No. : 10/810,911  
Page : 18

vertical position, it is difficult to gauge what is “a reasonable expectation of success.” It is fundamental that part of an invention can be discovery or recognition of a problem. Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. MPEP 2143; *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). The attached Expert Opinion supports the lack of any “expectation of success” under this second criteria on the basis that gaming cabinet doors have been made like “vaults” for years. Hence, there is no expectation of success in trying to come up with a vertically adjustable cross member, which is a substantial step away from a “vault-like” solid structure, especially where the gaming industry expects fixed, solid, permanent, vault-like structures. Further, the prior art does not teach or suggest a mount capable of supporting a cross member in a fastened position when in a selected vertical position.

Finally, a third criteria for an obviousness rejection is that the prior art reference (or references when combined) must teach or suggest all the claim limitations. As noted above, they don't. Specifically, the present invention provides a new function (i.e., vertically adjustable cross member) which is not shown or suggest in the art. Also, see the attached Expert Declaration which supports this position.

As noted above, the U.S. Supreme Court in *KSR Int'l v Teleflex, Inc*, 82 U.S.P.Q.2d 1385 (U.S. 2007) took the position that the test for obviousness was broader than a simple test of “teaching, suggestion, or motivation.” However, the KSR decision does not change the fact that the elements and/or function must be shown or suggest in the art. In fact, the KSR decision specifically encourages a common sense

Applicant : Orlando W. Stephenson III  
Appln. No. : 10/810,911  
Page : 19

approach. In the present case, neither cited art of Cole and/or Englman show or suggest a vertically-adjustable cross member, nor a mount as defined, nor even a reason to modify the existing art to make such members. Applicant argues that it is not “common sense” to combine a first reference that does not include any cross member (i.e., Cole) with second reference showing a permanently secured cross member (i.e., Englman) to reject claim 10 which requires a cross member that is fastened to a mount in a selected vertically-adjusted position, as defined in claim 10. The benefits of such a unique construction are not foreseeable, except through hindsight that uses the teaching of the present specification . . . which is improper.

Secondary considerations also support the unobviousness of the present invention. Like claim 1, the present invention as defined in claim 10 resolves a long felt but unresolved need in the industry for reconfigurable gaming cabinets that are able to be reconfigured to support changing games in this industry . . . without having to throw away existing gaming cabinets (or at least throw away and replace expensive complex doors). As noted in the Expert’s Declaration, the present invention has contributed to the present Applicant’s success in the marketplace, and is believed to be counterintuitive (i.e., the prior art teaches away from the present invention) due to an overriding antitheft-mentality (i.e., the gaming cabinets should be “vault-like”) in gaming industry.

The claims 11-21 depend from base claim 10 and are allowable since claim 10 is allowable for the reasons given above. These claims are also allowable since they define unobvious combinations with the subject matter of claim 10. For example, the prior art does not teach or suggest first and second fasteners as defined (claim 19), a mount comprising a flat

Applicant : Orlando W. Stephenson III  
Appln. No. : 10/810,911  
Page : 20

sheet (claim 20), nor a cross member with ends abutting the door and fasteners as defined (claim 21).

The new claim 25 defines a gaming machine including, among other things, a cabinet defining an internal space, a door for providing access to the internal space, the door having an enlarged opening defining vertical side edges, at least one sheet mounted to the door with a portion being see-through, and a generally horizontal cross member extending across the enlarged opening. The cross member has opposite ends positioned adjacent the vertical side edges when in any one of a plurality of vertically-adjusted positions. The door includes attachment structure in the internal space for attaching the cross member in any one of the vertically-adjusted positions, where “the cross member being a separate component but clamped against an outside of the door and secured to the door with the attachment structure in a selected one of the positions.” By this arrangement, the vertical position of the cross member can be adjusted during installation to vary the size of upper and lower portions of the enlarged opening above and below the cross member.

The cited art does not disclose or suggest any such arrangement as defined by claim 25. In particular, the cited art (including Cole and Englman) does not disclose or suggest several items defined in claim 25 and that are also found in claims 1 and 10 . . . which items are not found in the prior art as argued above in regard to claims 1 and 10. The prior art also does not disclose or suggest a cross member that is a separate component clamped against an outside of a door but secured with attachment structure in a selected (vertically-adjusted) position, as defined in claim 25.

It is noted that support for the language of claim 25 is found in the specification, such

Applicant : Orlando W. Stephenson III  
Appln. No. : 10/810,911  
Page : 21


as on page 4, paragraph [0015], line 6, where it states, "When installed, threaded nuts 42 are received on the studs 40, and draw the cross bar 12 securely against the beveled surface 39 of the door 6, . . . ." The recited attachment structure is intended to be broadly interpreted, but support for this language is found in the specification, such as in the discussion of the threaded studs 40, nuts 42, and the bosses on the door at 31 (Fig. 3).

For all of the above reasons, reconsideration is respectfully requested, and a Notice of Allowability for claims 1-25 earnestly solicited.

Respectfully submitted,

December 5, 2007  
Date

/DanielLGirdwood/

  
Daniel L. Girdwood, Registration No. 34 827  
Price, Heneveld, Cooper, DeWitt & Litton, LLP  
695 Kenmoor, S.E.  
Post Office Box 2567  
Grand Rapids, Michigan 49501  
(616) 949-9610

DLG/csd/dlc